

REMARKS

Applicants have amended claims 1, 6, 8, 13 – 17, 32 and 29, and canceled claims 33 and 34. Applicants have also amended the figures and specification to conform reference numbers in the text with those in the figures as well as to correct typographic errors and matters of form. Claims 1-32 are presented for examination.

Certain figures, the specification, and claim 8 have been objected to. Applicants have amended the figures, the specification, and claim 8 to address these objections.

Claims 6, 7, 13-18, and 32 are rejected under 35 U.S.C. §112 as being indefinite. Applicants have amended the claims to address the rejection and request that the rejection be withdrawn.

Claims 1-5, 8-15, 19-23, 25, and 29-34 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,056,700 (Burney). As amended, the claims recited a needle biopsy system comprising a marker lumen extending from a proximal end of a stylet to a marker exit opening. Burney does not teach or fairly suggest the claimed marker lumen. Instead, referring to Fig. 1 of Burney, for example, Burney describes a cavity 16 for carrying the marker 20 that does not extend from a proximal end of a stylet, as claimed. Thus, for at least this reason, the claims are not anticipated by Burney, and the rejection should be withdrawn.

Under 35 U.S.C. § 103(a), dependent claims 16-18 are rejected as allegedly obvious over Burney in view of U.S. Patent No. 5,853,366 (Dowlathshahi); dependent claim 24 is rejected as allegedly obvious over Burney in view of U.S. Patent Application No. 2002/0107437 (Sirimanne); and dependent claims 26 and 27 are rejected as allegedly obvious over Burney in view of U.S. Patent No. 6,173,715 B1 (Sinanan). Dowlathshahi, Sirimanne, and Sinanan do not cure the deficiencies of Burney as discussed above. Thus, dependent claims 16-18, 24, 26, and 27 are patentable for at least the same reasons that claim 1 is patentable. Applicants request these rejections be withdrawn.

Applicants also include an Information Disclosure Statement submitting references cited in a corresponding foreign application.

Applicants believe the claims are in condition for allowance, which action is requested.

Amendments to the Drawings:

The attached replacement sheets of drawings includes changes to Figs. 1, 2B, 2D, 5B, 5C, 6, 7A, 7B, and 8 and replaces the original sheets including Fig. 1, 2A, 2B, 2C, 2D, 2E, 5B, 5C, 6, 7A, 7B, and 8.

In Figure 1, reference character "8" is deleted.

In Figures 2B and 2D, reference character "31" is corrected to "32".

In Figures 5B and 5C, reference character "230" is corrected to "240" and reference character "240" is corrected to "230" in several places.

In Figure 6, reference characters "45" and "51" are deleted.

In Figure 7A, reference character "400" is added indicating the sampling portion.

In Figure 7B, reference character "400" is added indicating to the sampling portion and the reference characters "410" and "412" and the elements they indicate are moved left to be aligned over the magnet with the positive pole closest to the exterior of the stylet.

In Figure 8, reference character "300" is added indicating the marker.

Attachments following last page of this Amendment:

Replacement Sheets (6 pages)
Annotated Sheet Showing Change(s) (6 pages)


Applicant : Barry N. Gellman et al.
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Attorney's Docket No.: 01194-448001 / 02-229

No fees are believed to be due, but please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: March 10, 2005



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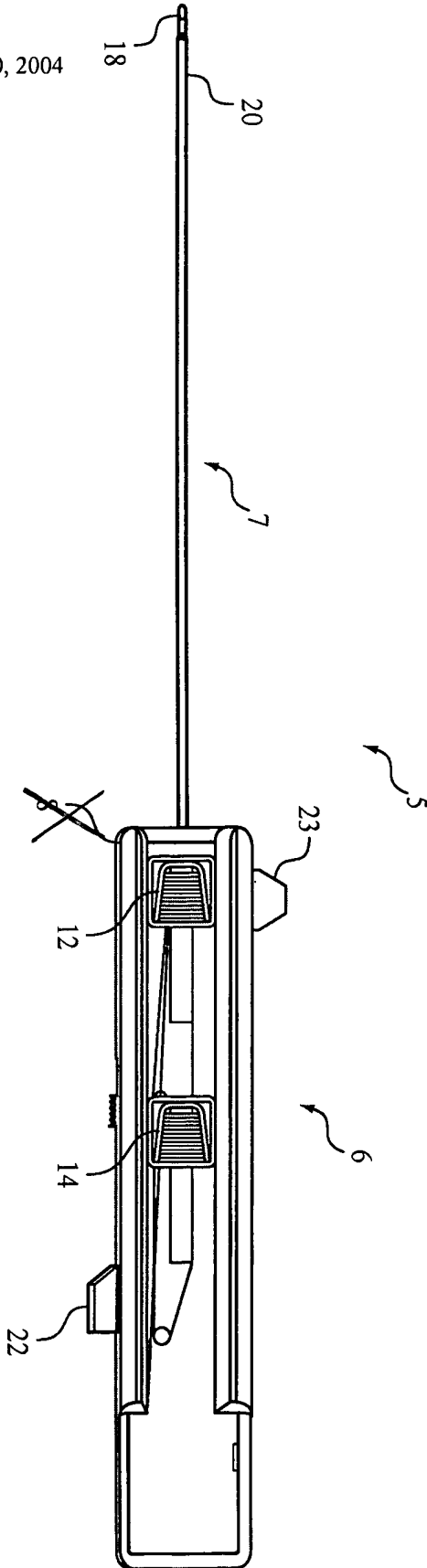


FIG. 1

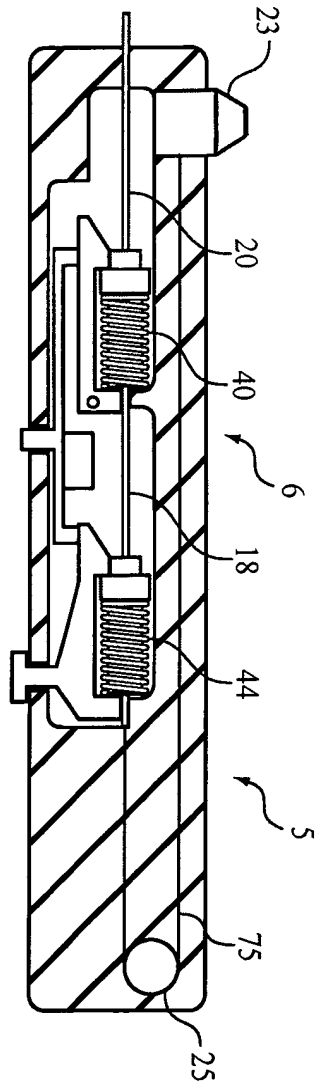


FIG. 2A

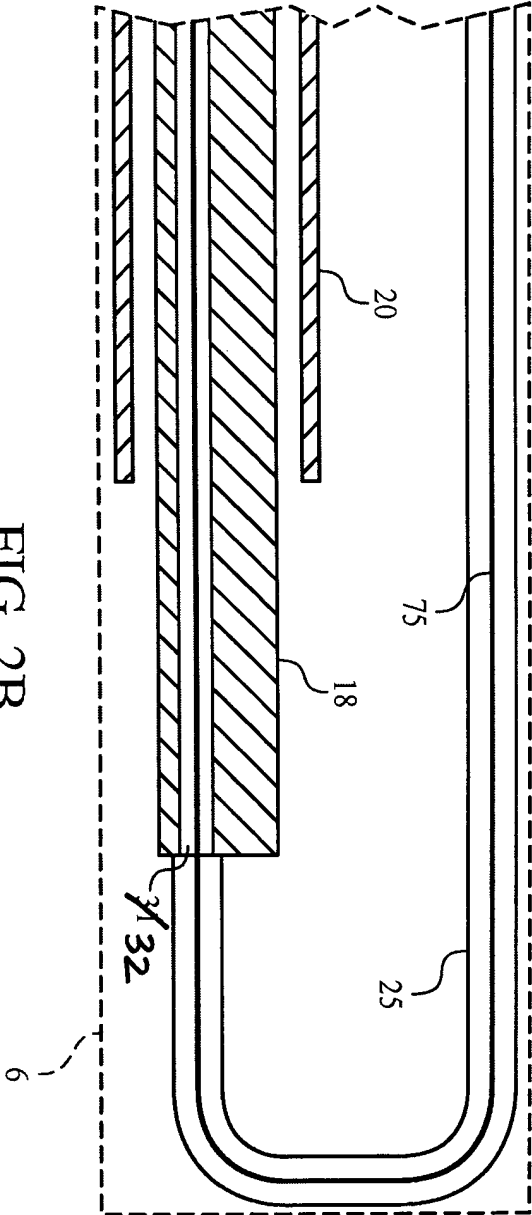


FIG. 2B

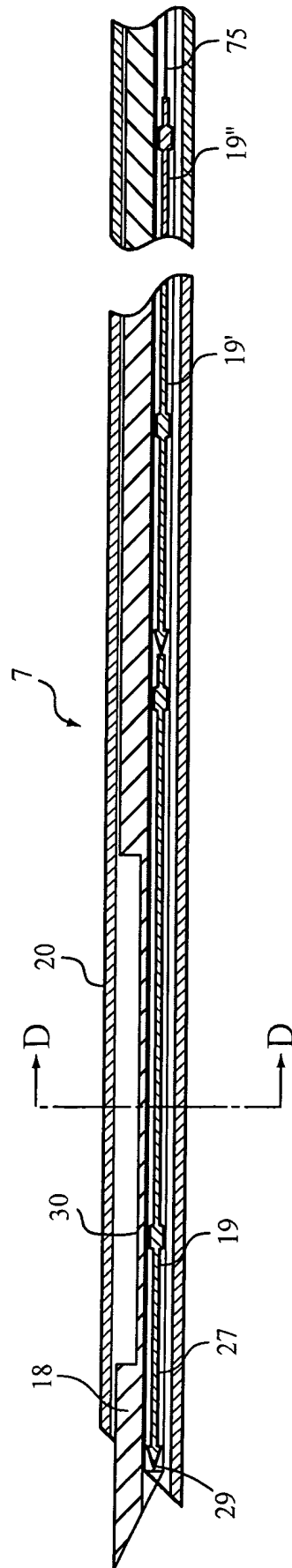


FIG. 2C

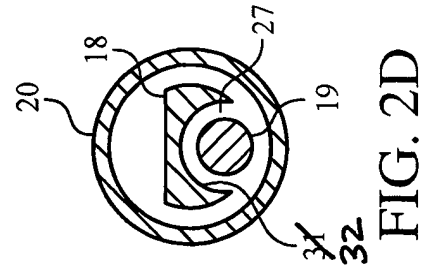


FIG. 2D

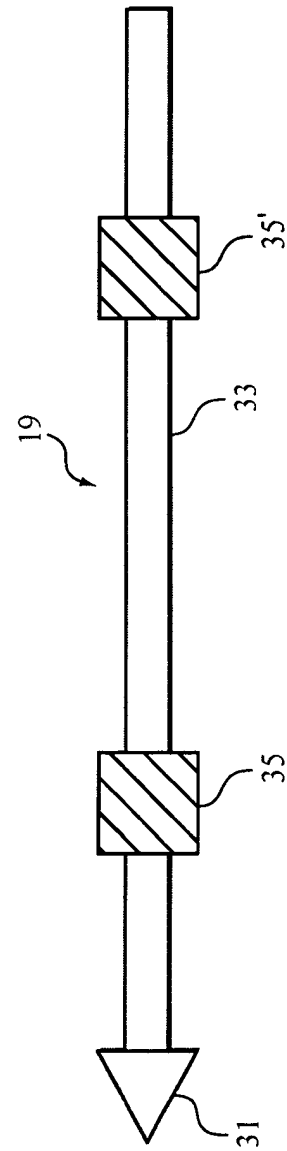
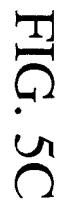


FIG. 2E



FIG. 5B



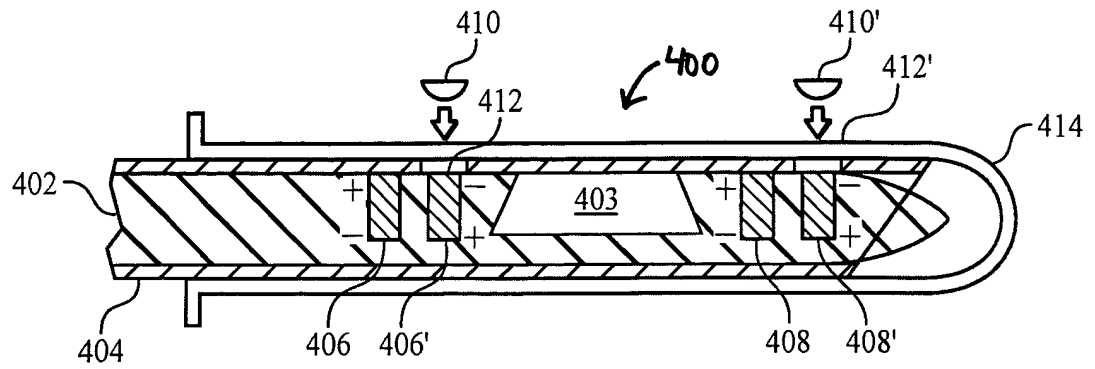


FIG. 7A

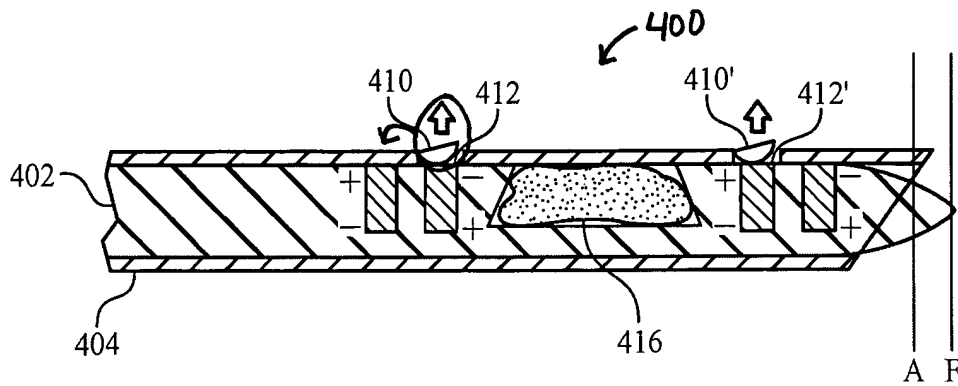


FIG. 7B

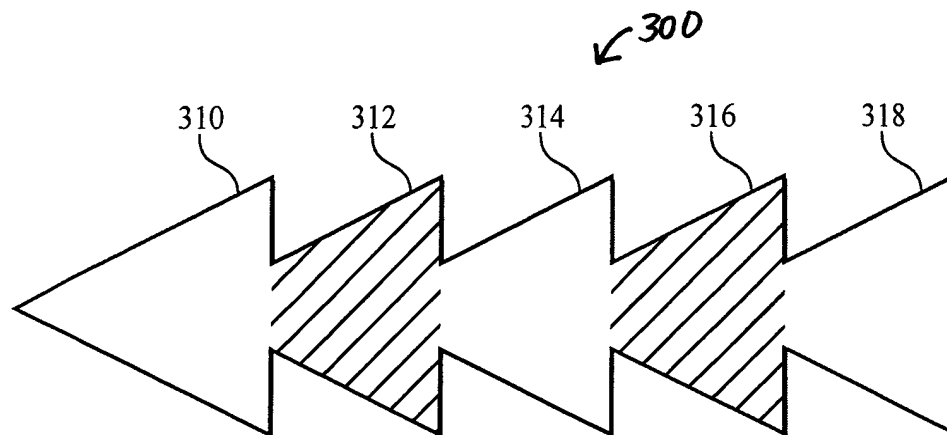


FIG. 8